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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Mark T. Cranna

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EXAMINER

DEXTER, CLARK F

ART UNIT

PAPER NUMBER

3724

MAIL DATE

DELIVERY MODE

06/10/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/695,951	CRANNA ET AL.	
	Examiner	Art Unit	
	Clark F. Dexter	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-14 and 21-57 is/are pending in the application.
- 4a) Of the above claim(s) 41-47 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5,7-14,21-40 and 48-50 is/are allowed.
- 6) ☒ Claim(s) 51-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed on March 3, 2010 has been entered.

Claim Rejections - 35 USC § 112, 2nd paragraph

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 51-56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 51, lines 1-2, the recitation "a portion that extends substantially parallel to the substantially planar back edge portion" is vague and indefinite as to whether it refers to that portion set forth in claim 1 or to another such portion.

In claim 52, lines 1-2, the recitation "a portion that extends substantially parallel to the substantially planar back edge portion" is vague and indefinite as to whether it refers to that portion set forth in claim 3 or to another such portion.

In claim 53, line 1, "the shelf" lacks antecedent basis; in lines 1-2, the recitation "a portion that extends substantially parallel to the substantially planar back edge portion" is vague and indefinite as to whether it refers to that portion set forth in claim 27 or to another such portion.

In claim 54, line 1, "the shelf" lacks antecedent basis; in lines 1-2, the recitation "a portion that extends substantially parallel to the substantially planar back edge

Art Unit: 3724

portion” is vague and indefinite as to whether it refers to that portion set forth in claim 31 or to another such portion.

In claim 55, line 1, “the shelf” lacks antecedent basis; in lines 1-2, the recitation “a portion that extends substantially parallel to the substantially planar back edge portion” is vague and indefinite as to whether it refers to that portion set forth in claim 34 or to another such portion.

In claim 56, lines 1-2, the recitation “a portion that extends substantially parallel to the substantially planar back edge portion” is vague and indefinite as to whether it refers to that portion set forth in claim 38 or to another such portion.

Claim Rejections - 35 USC § 102/103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject

matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 57 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nakahara, pn 6,834,573 with reference to related/equivalent disclosures of the Nakahara family of references.

Nakahara discloses a saw blade with every structural limitation of the claimed invention as described in detail in the Office action mailed January 23, 2008 and further including reliance on Fig. 6 which discloses a shelf of the claim language referring to the shelf including a surface 21 that meets the orientation and configuration of the corresponding shelf surface as set forth in the claims. It is noted that the surface 21 of Fig. 6 is considered to correspond to the surface 21 of Figs. 1A and 4A-C. It is further noted (as was noted in the previous Office action) that although these references are not prior art, they are equivalent/related disclosures of the Nakahara patent and upon careful consideration, appear to shed some light on portions of the Nakahara patent, particularly the structure shown in Fig. 6.

Further, Nakahara discloses:

[from claim 57] each of the shelves define a depth in a cutting direction of the blade within the range of about $6/100$ inch to about $1/10$ inch (e.g., the corresponding depth "A" of Nakahara is .25 mm to 1.5 mm which is approximately $1/100$ inch to $6/100$ inch);

each of the set teeth has a dimension (S1) defined as the distance between the tip and the shelf of the respective tooth within the range of about $6/100$ inch to about $12/100$ inch (e.g., the corresponding dimension "B" of Nakahara is 2 mm which is approximately $8/100$ inch);

each of the set teeth has a dimension (B) defined as the distance between the tip and the bend plane of the respective tooth; and

a ratio of S1/B is within the range of approximately $1/4$ to approximately $3/4$ (e.g., as viewed in Fig. 3, the ratio clearly taught to one having ordinary skill in the art is about $1/2$).

In the alternative, if it is argued that Nakahara does not sufficiently disclose all of the claimed ratios/dimensions, the Examiner respectfully maintains that these ratios/dimensions would be the mere discovery of the optimum or workable ranges within the general conditions of the prior art and therefore obvious to one having ordinary skill in the art. Further, to scale up or down the blade of Nakahara such that the dimensions are met would be well within the skill of one having ordinary skill in the art and therefore obvious over the Nakahara.

Allowable Subject Matter

7. Claims 1-5, 7-14, 21-40 and 48-50 are allowable over the prior art of record.

Response to Arguments

8. Applicant's arguments filed March 3, 2010 have been fully considered but they are not persuasive.

On pages 14-18 of the subject response, applicant argues that the prior art does not meet the claimed dimensions and that modifying these dimensions in Nakahara would not have been obvious to one having ordinary skill in the art.

First, with respect to the specific ratios/dimensions set forth in the dependent claims, applicant's arguments are moot in view of the indicated allowability of the independent claims.

Second, regarding independent claim 57, it is respectfully submitted that Nakahara anticipates this claim as explained in the prior art rejection above. Further, as set forth in the prior art rejection, it is respectfully submitted that the specific dimensions set forth are based on blade size, and to scale up or down the blade of Nakahara such that the dimensions are met would be well within the skill of one having ordinary skill in the art and therefore such limitations are not considered to patentably distinguish the claimed invention over the prior art.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3724

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Clark F. Dexter/
Primary Examiner, Art Unit 3724**

cf
June 7, 2010